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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/489,784 01/24/00 MOHROR

R P04345USO PH

027310 HM22/0705
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EXAMINER

FOX, D

ART UNIT

PAPER NUMBER

1638
DATE MAILED:

4
07/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/489,784

Applicant(s)

McHror

Examiner

FOX

Group Art Unit

1638

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-32 is/are pending in the application.
Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-32 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 2
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1638.

Claims 1, 5, and 7 are objected to for their inclusion of blank lines. It is understood that the blanks will be replaced with the deposit accession number.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6, 8-11, 13-15, 17-19, 21-24, 26-28 and 30-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 8 and 21 are indefinite in their recitation of "wherein said plant is male sterile", since the claims from which they depend are drawn to plants which are not male sterile. If Applicant intended to claim a plant derived from the plant of the preceding claim, further comprising a genetic factor for male sterility, then the claims should be so amended. New matter should be avoided.

Claim 6 is indefinite in its recitation of "the...protoplasts" which lacks antecedent basis in the preceding claims. The claim should be amended to delete "the" before "cells" and to insert -- of the tissue culture-- after "protoplasts".

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Claims 11, 15, 19, 24, 28 and 32 are indefinite in their recitation of “high”, “strong”, “above average”, “good”, “low”, “moderate” and “particularly” which are unduly narrative, and which do not clearly set forth the claimed characteristics or the degree of their expression.

Claims 9, 13, 17, 22, 26 and 30 are indefinite in their recitation of “include”, as it is unclear whether this is an open or closed term. Furthermore, the claims are indefinite for failing to positively recite essential method steps, in their mere recitation of “obtaining” in the body of the claim.

Claims 10, 14, 18, 23, 27 and 31 are indefinite in their recitation of “The maize breeding program of claim 9 [or 13 etc.]”, since the preceding claims were drawn to a method rather than a breeding program.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11, 15, 19, 24, 28 and 32 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Roundy (U.S. Patent 5,773,682).

Roundy teaches a maize hybrid with good resistance to Gray Leaf Spot, strong yield, very good stalk lodging resistance, above average root lodging resistance and strong staygreen (see, e.g., column 10, lines 60-67; column 13, Table 1, item 9). The maize plant taught by Roundy differs from the claimed maize plants only in their derivation from 31R88. However, the mere

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inclusion of 31R88 in the pedigree of the claimed plants would not distinguish them from the prior art plants, particularly since the number of other parents, crosses or generations is not specified in the claims, wherein increasing the number of each parameter would result in a decrease in 31R88-derived genes. See *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985), which teaches that a product-by-process claim may be properly rejectable over prior art teaching the same product produced by a different process, if the process of making the product fails to distinguish the two products.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roundy (U.S. Patent 5,773,682).

Roundy teaches a maize Dent hybrid with absent anthocyanin in the brace roots, dark green leaves, no leaf sheath pubescence, yellow anthers, light green glumes, light green silks, upright ear, red cob, strong staygreen, strong yield, very good stalk lodging resistance, above average root lodging resistance, and good resistance to Southern Leaf Blight; wherein said hybrid was derived by crossing other plants with desirable agronomic characteristics, and also teaches tissue culture and the use of the hybrid as a source of genetic material for other crosses (see, e.g.,

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column 1, lines 51-61; column 2, lines 59-67; column 3; column 5, lines 26-41; column 10, lines 60-67; columns 11-14; column 15, lines 1-32; column 21).

Roundy does not teach a maize plant with slightly curved kernel rows.

It would have been obvious to one of ordinary skill in the art to utilize the maize inbred taught by Roundy, and to modify that inbred by crossing with other maize plants to incorporate desired agronomic characteristics, as suggested by the reference.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fox whose telephone number is (703) 308-0280. The examiner can normally be reached on Monday through Friday from 9:30AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, can be reached on (703) 308-4310. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

July 2, 2001

DAVID T. FOX
PRIMARY EXAMINER
GROUP ~~180~~ 1638

